

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Wolfgang RUF et al.
Appln. No : 10/072,876
Filed : February 12, 2002
For : LAMELLA OF A HEADBOX OF A PAPER, CARDBOARD OR
TISSUE MACHINE

Group Art Unit: 1731
Examiner: J. Fortuna

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer dated December 23, 2003, the period for reply extending until February 23, 2004.

In the Examiner's Answer, the Examiner has maintained the grounds of rejection advanced in the Final Office Action and provides arguments in support thereof.

Appellants note that this Reply Brief is being filed under 37 C.F.R. 1.193(b)(1) and is directed to the arguments presented in the Examiner's Answer, and is therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note that they are addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

Examiner Asserts that Ruf Discloses a Non-planar Surface

On the Page 6, section 11 (*Response to Argument*), the Examiner, addressing Appellants' position that the second surface of RUF is planar, asserts that "figures 5-8 show the non-planarity of the surfaces." [footnote omitted]. Moreover, in the footnote, the Examiner set forth that a non-planar surface is a structure in which at least part of the structure is located in a different plane with respect to another.

With regard to the foregoing, Appellants do not agree with the Examiner's position that a non-planar surface is accurately described as a "structure." Rather, a non-planar surface is a surface in which all points of the surface are not included within a common plane.

While Appellants assume that this definition can be agreed upon, the dispute in the instant application appears directed to the inquiry "what is a surface?" within the context of the pending application and claims.

From the Examiner's Answer, it appears that the Examiner's position is that a non-planar surface is the result of a combination of two obliquely oriented planar surfaces. However, Appellants note that the Examiner has not provided any documentary evidence to support his position, and pointed to no teaching in RUF that the two joined surfaces form a non-planar surface.

In fact, Appellants submit that one ordinarily skilled in the art reviewing RUF would understand that the lamella is composed of a number of surfaces oriented in different directions, and that there is no disclosure of a non-planar surface along the periphery of the RUF lamella. As a result, Appellants submit that there is no disclosure in RUF that any of the illustrated “surfaces” are non-planar surfaces, such that RUF fails to anticipate the features of the instant invention as recited in at least the independent claims.

Accordingly, Appellants request that the Board of Patent Appeals and Interferences reverse the Examiner’s decision to finally reject claims 1 - 3, 11, 15, 17 - 23, 31, 35, 37 - 42, 44, and 48 - 50 and remand the application to the examining group for early allowance of the same.

Second Issue

Examiner Asserts that Sanford Anticipates Invention

On page 8, section 11 (*Response to Argument*) of the Examiner’s Answer, the Examiner, in addressing Appellants’ arguments with respect to the anticipation rejection over SANFORD, asserts that he has shown the different non-planar surface(s) of the lamella in SANFORD.

However, Appellants note that their arguments with respect to SANFORD were that SANFORD fails to show a portion coupled to and sloped relative to the first surface, as recited in at least independent claims 1, 22, and 44. In this regard, Appellants note that

neither the Final Office Action nor the Examiner's Answer identifies any disclosure in SANFORD that shows the above-noted feature of the instant invention.

Because the record fails to show each and every recited feature of at least the independent claims being disclosed by SANFORD, Appellants submit that the instant rejection is improper and should be reversed and remanded to the examining group for allowance by the Board.

Third Issue

Examiner Mischaracterizes Appellants' Remarks Regarding Issue (C)

On page 8, section 11 (*Response to Argument*) of the Examiner's Answer, the Examiner, in addressing Appellants' arguments with respect to the obviousness rejection over RUF in view of SANFORD, asserts that Appellants have merely recited the features of the claims without stating why the combination of references is improper.

Appellants note that the impropriety of the asserted combination of RUF in view of SANFORD was fully developed on pages 14 and 15 of the Appeal Brief. In particular, Appellants pointed out Figure 2 of RUF, which illustrates a view of the apparatus looking into the nozzle (direction II depicted in Figure 1), in which a constant distance is maintained between the surface of nozzle tips 1 and 1' and lamella 2. That is, RUF discloses that tip t should be as exactly straight-lined as possible from side wall to side wall, i.e., it should be *as close as possible to parallel to the outlet ends*, see RUF, column 4, lines 16 - 23.

In view of this teaching of RUF, Appellants noted that not only is there no teaching or suggestion of a non-planar surface on the lamella, but that RUF specifically teaches against the use of a lamella having a non-planar surface and against the modification of RUF asserted by the Examiner in the instant rejection.

Appellants further noted that, notwithstanding the assertions of obviousness, the Examiner has not presented or shown a reason *why* one of ordinary skill in the art would have been led to modify RUF in manner asserted by the Examiner, particularly since RUF expressly discloses that the surfaces should be parallel in order to obtain the desired operation of the headbox. Thus, Appellants submit that the modification asserted by the Examiner is contrary to the express disclosure of RUF, and, therefore, would not have been obvious under 35 U.S.C. § 103(a).

Because the art of record fails to provide the necessary motivation or rationale for combining the documents in manner set forth by the Examiner, Appellants submit that the instant rejection is improper and should be reversed and remanded to the examining group for allowance.

Fourth Issue

No Documentary Evidence to Support Assertions of Obviousness

On page 8, section 11 (*Response to Argument*) of the Examiner's Answer, the Examiner asserts that his assertions of obviousness in the obviousness rejections over RUF

and SANFORD are based upon knowledge within the level of ordinary skill at the time of the invention, and do not include knowledge gleaned from Appellants' disclosure.

With regard to RUF, Appellants note that the applied document fails to provide any teaching or suggestion of a lamella having a non-planar second lamella surface, as recited in at least independent claims. Moreover, Appellants note that, as RUF actually teaches against such a modification, i.e., RUF intends tip t of the lamella be as exactly straight-lined as possible from side wall to side wall, there is no suggestion regarding a non-planar second surface, as recited in the instant invention.

Moreover, Appellants note that, other than maintaining the tip t to be as exactly straight-lined as possible, RUF fails to provide any teaching or suggestions to "optimize" the lamella, and certainly fails to provide any guidance to one ordinarily skilled in the art to modify dimensions, positioning, materials, etc., to enhance the disclosed lamella.

With respect to SANFORD, Appellants note that the grooves formed in the surfaces are utilized to achieve the desired operation of the headbox, and there is no teaching or suggestion that forming an additional lamella surface obliquely to a first surface would enable SANFORD to continue operating in its intended manner. That is, SANFORD discloses a specific arrangement of grooves on opposing sides of a lamella, but there is no teaching or suggestion as to how suspension flow over these surfaces would be changed/disrupted due to adding an additional oblique surface to the lamella.

Like RUF above, Appellants submit that SANFORD fails to provide any teaching or suggestions to “optimize” the lamella, and certainly fails to provide any guidance to one ordinarily skilled in the art to modify dimensions, positioning, materials, etc., to enhance the disclosed lamella.

Further, Appellants note that the lamellae of the instant invention is structured so as to avoid instabilities in flow conditions and to avoid a tendencies to oscillate. Appellants note that, as neither RUF nor SANFORD identify the problem to be addressed by the instant invention, Appellants submit that the only reasonable rationale for modifying either RUF or SANFORD in the manner asserted by the Examiner is from reviewing the instant application. Moreover, because neither applied document provides any suggestion as to what might be expected from modifying the lamellae from the respective documents in the manner asserted by the Examiner, Appellants submit that these documents cannot render obvious the instant invention.

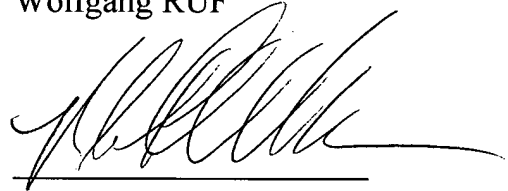
Thus, Appellants submit that neither RUF nor SANFORD provides any teaching or suggestion that would render the instant invention obvious. Moreover, Appellants submit that neither applied document of record provides the necessary motivation or rationale for modification in the manner asserted by the Examiner. Therefore, Appellants submit that the instant rejection is improper and should be reversed and remanded to the Examiner for allowance.

CONCLUSION

For the reasons expressed above, Appellants respectfully request that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

This Reply Brief is submitted herewith in triplicate for the convenience of the Board. Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellants respectfully request an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
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February 23, 2004
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